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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,895	03/28/2001	Keiichi Onodera	041514-5116	9524

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EXAMINER

PHAM, HAI CHI

ART UNIT	PAPER NUMBER
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2861

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,895

Applicant(s)

ONODERA ET AL.

Examiner

Hai C. Pham

Art Unit

2861

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24, 25 and 58-88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24, 25 and 58-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

FINAL REJECTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 24, 58, 60-61, 64-65, 67-68, 71-72, 74-75, 78-79, and 81-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koyama (US 6,556,234) in view of Wen (US 5,915,858).

With regard to claim 24, Koyama discloses an apparatus for writing a visible image pattern onto an unrecorded area of an optical recording medium, the apparatus comprising a driving component for driving the optical recording medium (the driving component being inherent to the apparatus driving the disc during writing of a visible image pattern), and a writing component (the same laser as the recording means 13 or an additional laser scanning, not shown) (col. 3, lines 8-10) for forming a visible image pattern (7) by irradiating of light on a recording layer formed in the optical recording medium to generate a change in optical characteristic of the recording layer where pits are formed with the light as compared to a pit-less portion where pits are not formed (col. 2, lines 42-58) (col. 4, lines 1-12), a data generating component (i.e., image processing box 9) for generating character data to produce image data for forming the visible image pattern, wherein said writing component modulates the light based on

Art Unit: 2861

said image data produced from said character data and irradiates the modulated light on the recording layer (col. 3, lines 8-10), an editing component for editing said image data produced from said character data (the image processing 9 processes the image pattern by varying the size and the number in accordance with the space available for recording the image pattern) (col. 3, lines 44-46), a reading component (e.g., using a light source and an optical reading head, not shown) for optically reading information already recorded in said recording layer of said optical recording medium (col. 2, lines 30-37), wherein said editing component obtains a width of an unrecorded area in said recording layer based on information read by said reading component or reflected light quantity from said optical recording medium (in box 8 of Fig. 3, the non recorded annular data area or particularly the radial width 6 of the non recorded data area of the disc is determined based on the difference in the reflectance between the information recording area and the non recorded data area to the edge of the disc) (col. 3, lines 26-31), compares in size said visible image pattern by said image data with said unrecorded area (the determined patterns varied in size and number, and the space available in the non recorded data area forms the basis for processing the determined pattern to be performed in box 9) (col. 3, lines 42-46), and automatically edits said image data for forming the visible image pattern so that the visible image pattern does not extend beyond said unrecorded area (the size of the determined pattern being edited in box 9 in accordance with the space available in the non recorded data area, i.e., to lie within the delimitations of the non recorded data area) (col. 2, lines 59-63) (col. 3, lines 42-46).

With regard to claim 71, Koyama again teaches a writing component for forming a pit-art recording of visible image pattern in the non recorded area of the recording layer of the disc with pits formed by irradiation of a writing light beam in addition to the data recording based on an input data as ordinary data within the recorded area (5), the writing component can be configured with a single laser source or two separate laser sources (col. 3, lines 1-11).

The method claims 64 and 78 are deemed to be clearly anticipated by functions of the above structures.

Although Koyama indicates that the determined pattern being inputted (col. 3, lines 32-33), Koyama does not however explicitly disclose the data acquiring component for acquiring the visible image pattern, the data acquiring component automatically acquiring the character data from an optical or electrical signal source such as a CD.

Wen discloses a CD label printing system wherein the character data for forming the label is automatically retrieved during the process by the computer (60) from the computer disk (84), which comprises an optical disc, and from a remote storage device (74) such as internet via communication means (76), which can be cables or radio transmitters (col. 6, lines 6-33).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the device of Koyama by incorporating the data acquiring component for retrieving the character data for forming the CD label from an

external device such as an compact disc as taught by Wen. The motivation for doing so would have been to allow the import of the visual patterns to create custom labels.

With regard to claims 58, 65, 72 and 79, Koyama further teaches a preview image generating part (a display, not shown) for generating a preview image of the visible image pattern formed by use if said image data automatically edited (the determined patterns are processed and shown to the user) (col. 3, lines 32-34).

3. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koyama in view of Wen and Nimura et al. (US 5,023,728).

Koyama in view of Wen discloses all the basic limitations of the claimed invention (please refer to the above paragraph 2 for the rejection of the similar claimed limitations) except for the prohibition of the formation of the visible image pattern when the width of the unrecorded area of the recording medium is found smaller than the width of the visible image pattern.

Regardless, Nimura et al. discloses an image processing and recording apparatus including a means for prohibiting the recording operation when the remaining amount of the recording sheet is smaller than the image size to be recorded as it is detected and displayed to the user (col. 2, lines 15-19).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to implement the inhibition of the image formation operation in the device of Koyama when the detected image recording area is smaller than the size of the image to be formed as taught by Nimura et al. The motivation for

doing so would have been to prevent unnecessary image forming operation, which would otherwise result in a poor printing.

4. Claims 59, 66, 73 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koyama in view of Wen, as applied to claims 24, 58, 64-65, 71-72, 78-79 above, and further in view of Nimura et al.

Koyama in view of Wen discloses all the basic limitations of the claimed invention except for the prohibition of the formation of the visible image pattern when the width of the unrecorded area of the recording medium is found smaller than the width of the visible image pattern.

Regardless, Nimura et al. discloses an image processing and recording apparatus including a means for prohibiting the recording operation when the remaining amount of the recording sheet is smaller than the image size to be recorded as it is detected and displayed to the user with the option of canceling the recording operation (col. 2, lines 15-19) (Fig. 13).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to implement the inhibition of the image formation operation in the device of Koyama when the detected image recording area is smaller than the size of the image to be formed as taught by Nimura et al. The motivation for doing so would have been to prevent unnecessary image forming operation, which would otherwise result in a poor printing.

5. Claims 61-63, 68-70, 75-77 and 82-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kayama in view of Wen, as applied to claims 24, 60, 64, 67, 71, 74, 78, 81 above, and further in view of Wilkins (US 6,788,812).

Kayama in view of Wen discloses all the basic limitations of the claimed invention except for the optical or electrical signal source being from a television tuner whose output signal is a communication satellite or broadcast satellite.

Wilkins discloses a method for acquiring, processing and printing a digital image, whose information data is provided by the image source such as a TV tuner, a set top box with satellite DSS or cable signal (col. 8, lines 7-30).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide the device of Koyama with an image source such as the TV tuner as taught by Wilkins. The motivation for doing so would have been to allow the device to retrieve image from a versatile number of image sources for producing customized labels of the disc.

6. Claims 85-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koyama in view of Wen, as applied to claims 24, 64, 71, 78 above, and further in view of Inoue et al. (US 6,388,766).

Koyama in view of Wen discloses all the basic limitations of the claimed invention except for the data acquiring component acquires said character data from the table-of-contents (TOC) data of a finalized CD-R.

Inoue et al. discloses a dubbing apparatus for recording information data on a disc as well as for printing a label on the disc D, the apparatus being provided with a data acquiring component for retrieving the information data as well as the character data for forming the label that describes the information data to be recorded from an external device such as from an external optical disc drive (45) and from the internet. Inoue et al. further teaches the character data being recorded in a predetermined sector of the TOC, to be read and display to the user (col. 28, line 66 to col. 29, line 7) (col. 29, line 66 to col. 30, line 13).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the device of Koyama by having the acquiring data component to acquire the character data from the table-of-contents of the optical disc as taught by Inoue et al. The motivation for doing so would have been to easily and accurately retrieve the needed character data recorded on the disc since the table-of-contents of the disc keeps track all the information related to the location and format of the recorded data on the disc.

Response to Arguments

7. Applicant's arguments with respect to claims 24-25 and 58-88 have been considered but are moot in view of the new grounds of rejection.

Conclusion

8. Applicant's amendment, which changed the scope of the claims, necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai C. Pham whose telephone number is (571) 272-2260. The examiner can normally be reached on M-F 8:30AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vip Patel can be reached on (571) 272-2458. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2861

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



HAI PHAM
PRIMARY EXAMINER

October 10, 2006